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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/811,690  
Filing Date: March 29, 2004  
Appellant(s): MARMO, J. CHRISTOPHER

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Brigitte C. Phan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3 June 2008 appealing from the Office action mailed 5 December 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 172-178 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al (US 2001/0044482), Gordon (US 4,123,408), or Shah (US 4,462,665) each taken in view of Dziabo et al (US 5,338,408), only.

Claims 172-178 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 6,008,170) or Salpekar et al (US 6,440,366), each taken in view of Dziabo et al (US 5,338,408), only.

All other grounds of rejection are being maintained.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

2001/0044482	Hu et al	11-2001
6,440,366	Salpekar et al	8-2002
6,008,170	Tanaka et al	12-1999
4,462,665	Shah	7-1984
4,123,408	Gordon	10-1978
3,954,644	Krezanoski et al	5-1976

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 172-178 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al (US 2001/0044482), Gordon (US 4,123,408), or Shah (US 4,462,665) each taken in view of Krezanoski et al (US 3,954,644).

The reference to Hu et al (US 2001/0044482) shows the contemplated contact lens employed in the instant claims at the Abstract, paragraphs [0017]-[0019], [0022], [0029], [0032]-[0035], [0047]-[0048], [0051] and the many Examples.

The reference to Gordon (US 4,123,408) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (lines 38-55), column 3 (line 64) to column 6 (line 63), the Example at columns 8 and 9 and the claims.

The reference to Shah (US 4,462,665) shows the contemplated contact lens employed in the instant claims at the Abstract, column 2 (line 1) to column 4 (line 49), the many Examples and the claims.

The reference to Krezanoski et al (US 3,954,644) show the storage and cleaning of contact lenses using polymers, as herein recited and claimed. The patent to Krezanoski et al shows the use of polyalkylene glycol polymers for storage and cleaning of contact lenses. Note the Abstract.

The primary references teach the contact lens of the claims. The secondary reference shows the solutions for cleaning/storage and show such as conventional, as recited herein. As such, the use of the solutions for cleaning/storage with the contact lenses of either primary reference would have been a *prima facie* obvious modification, as being standard in this art. Contact lenses, especially hydrophilic lenses, are stored in liquid to prevent their drying out and becoming brittle and useless. The employment of a package is notoriously obvious since the product must be vended and distributed, or stored prior to distribution. The packaging thereof would have been *prima facie* obvious to an artisan in view of the references, but also, in view of standard practice in this art. As such, a skilled artisan would have a high level of expectation of success following the teachings of the references. Nothing unexpected is shown on the record. The recitation of "single use" provides no patentable distinction since it is intended to be used at least once. The recitation and the claim language of "comprising" does not exclude the use of the lens a multiple number of times, or that a multi-use lens may not be included in the "package system" recited. Likewise, it is a hoary employment of sterile packaging for contact lenses, to do otherwise would be detrimental and harmful. Again, applicant has failed to show any unexpected or surprising results.

Claims 172-178 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 6,008,170) or Salpekar et al (US 6,440,366), each taken in view of Krezanoski et al (US 3,954,644).

The reference to Tanaka et al (US 6,008,170) shows the contemplated contact lens employed in the instant claims at the Abstract, the paragraph bridging column 3 to column 4, column 6 (lines 45-61), the Examples and claims.

The reference to Salpekar et al (US 6,440,366) shows the contemplated contact lens employed in the instant claims at the Abstract, column 3 (line 53) to column 7 (line 57), the Examples and the claims.

Note in Dziabo et al at the paragraph bridging column 5 to column 6) for the use of polymers derived from vinyl ethers. The patent to Krezanoski et al shows the use of polyalkylene glycol polymers for storage and cleaning of contact lenses. Note the Abstract.

The primary references teach the production of the contact lens of the claims. The secondary reference shows the solutions for cleaning/storage and show such as conventional, as recited herein. The use of such solutions with the contact lenses, as claimed, would have been a *prima facie* obvious modification to a skilled artisan. Contact lenses, especially hydrophilic lenses, are stored in liquid to prevent their drying out and becoming brittle and useless. The employment of a package is notoriously obvious since the product must be vended and distributed, or stored prior to distribution. The packaging thereof would have been *prima facie* obvious to an artisan in view of the references, but also, in view of standard practice in this art. The employment of a

package is notoriously obvious since the product must be vended and distributed. As such, a skilled artisan would have a high level of expectation of success following the teachings of the references. Nothing unexpected is shown on the record. The recitation of “single use” provides no patentable distinction since it is intended to be used at least once. The recitation and the claim language of “comprising” does not exclude the use of the lens a multiple number of times, or that a multi-use lens may not be included in the “package system” recited. Likewise, it is a hoary employment of sterile packaging for contact lenses, to do otherwise would be detrimental and harmful. Again, applicant has failed to show any unexpected or surprising results.

#### **(10) Response to Argument**

Appellant argues that a *prima facie* case of obviousness has not been tendered by the Examiner. This is not so. Appellant argues each reference as though it were the subject of a rejection made under 35 USC 102, which is not the case. The references employ each of the constituents/components in identical fashion as recited herein. The argument that “the cited references taken alone or in any combination do not teach or suggest a package system as recited in any of (the) independent claims,” and the cited references taken alone or in any combination do not teach or suggest contact lens package systems that include the recited contact lens, the recited sterile packaging liquid medium, wherein both the contact lens and the sterile packaging liquid medium comprise...a polyalkylene glycol” ignores the teachings of the references, as set out above. The primary references teach the contact lens of the claims. The secondary

references show the solutions for cleaning/storage and show such as conventional, as recited herein. As such, the use of the solutions for cleaning/storage with the contact lenses of either primary reference would have been a *prima facie* obvious modification, as being standard in this art. Contact lenses, especially hydrophilic lenses, are stored in liquid to prevent their drying out and becoming brittle and useless. The employment of a package is notoriously obvious since the product must be vended and distributed, or stored prior to distribution. The packaging thereof would have been *prima facie* obvious to an artisan in view of the references, but also, in view of standard practice in this art.

A finite number of constituents are disclosed in the references for employ. The employment of known constituents in known capacities would yield predictable results. Commercially available for many years, solutions suitable for cleaning and storage (in the same bottle) are notoriously old in the art. The recitation of "single use" provides no patentable distinction since it is intended to be used at least once. The recitation and the claim language of "comprising" does not exclude the use of the lens a multiple number of times, or that a multi-use lens may not be included in the "package system" recited. Likewise, it is a hoary employment of sterile packaging for contact lenses, to do otherwise could be detrimental and harmful. Again, applicant has failed to show any unexpected or surprising results. Regarding Hu et al, the reference shows the use of polyethylene glycol in the hydrophilic contact lens, at paragraph [0029], as previously pointed out. Gordon shows the same at the paragraph bridging column 5 to column 6. Shah teaches the use at the paragraph bridging column 3 to column 4. No specific polyalkylene glycol is recited in claim 172. All of this has previously been pointed out to

Appellant. Appellant argues each reference without regard to the skill of an artisan in this art, though the references, taken as a whole, teach the instantly claimed invention.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nathan M. Nutter/

Primary Examiner, Art Unit 1796

Conferees:

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